

Appl. No. 10/666,570
Dated 04/05/2005
Reply to Office Action of 01/05/2005

REMARKS

This paper is in response to the Office Action mailed on 01/05/2005. In the Office Action, (i) claims 14-18, 21 and 30-32 were rejected under 35 USC 101; and (ii) claims 14-18, 21 and 30-32 were rejected under the judicially double patenting doctrine. Reconsideration of the rejections is respectfully requested in view of the remarks and amendments made herein.

Claims 14-18, 21, and 30-32 were previously pending. Applicant has amended independent claims 14 and 16 by this response. No claim was cancelled by this response. New claims 33-37 have been added. Accordingly, claims 14-18, 21, and 30-37 are now pending in the patent application. Of the pending claims, claims 14, 16, and 33 are independent claims.

Applicant believes that no new matter has been added by this response.

I) CLAIM REJECTION UNDER 35 U.S.C. § 101

Claims 14-18, 21, and 30-32 were rejected under 35 U.S.C. § 101 as it is alleged that the claimed invention is directed to non-statutory subject matter lacking patentable utility. Applicant respectfully traverses.

Applicant amended independent claims 14 and 16 adding "to convert voice and data samples into packets for transmission over a network and to convert packets received from the network into voice and data samples" in each of the preambles to clarify the practical application of Applicant's claimed invention.

Applicant respectfully submits that claims 14-18, 21, and 30-32 are now directed to instruction set architectures that are used

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to produce a "useful, concrete and tangible result". [MPEP § 2106(II) (A), 8th Ed., Rev. 1, Feb. 2003, page 2100-6 citing State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368 at 1373, 47 USPQ2D 1596 at 1601-02 (Fed. Cir. 1998)].

"Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." [MPEP § 2106(II) (A), 8th Ed., Rev. 1, Feb. 2003, page 2100-7].

Thus, Applicant respectfully requests the withdrawal of the 35 USC 101 rejection of claims 14-18, 21 and 30-32.

II) CLAIM REJECTION - JUDICIAL DOUBLE PATENTING

Claims 14-18, 21 and 30-32 were rejected under the judicially created doctrine of double patenting in view of claims 5-10 of United States Patent No. 6,772,319. Applicant respectfully traverses.

Claims 5-10 of U.S. Pat. No. 6,772,319 correspond to Application claim numbers 38-43 of U.S. Application No. 10/215,721.

An office action mailed on 02/11/2003 in Application No. 10/215,721 found claims 14-18 and 21 in Group I to be patentably distinct as being "drawn to an Instruction Set Architecture with including instructions to perform (A op1 B) op2 C function, classified in class 712, subclass 200". In the same office action, claims 22-37 (related to claims 38-43) were restricted into Group II as being "drawn to an instruction set architecture including control instructions, classified in class 712, subclass 200". Claims 38-43 directed to Group II were added into U.S.

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Application No. 10/215,721 in response to the office action mailed on 02/11/2003.

In the Office Action mailed on 10/26/2004 in this application, Claims 14-18 and 21 of Group I were restricted for being "drawn to a DSP instruction set architecture of type D={A Op1 B) Op2 C) in 20 bit and 40 bit format, classified in class 712, subclass 223". In the same Office Action, claims 23-29 were restricted into Group II as being "drawn to a DSP instruction set architecture with RISC unit control instructions to control execution of DSP instructions, classified in class 712, subclass 35."

Thus, Applicant respectfully submits that claims 14-18 and 21 were previously found to be patentably distinct. As claims 30-32 depend from independent claim 14, these claims are patentably distinct as well.

Thus, Applicant respectfully requests reconsideration of judicial double patenting rejection of claims 14-18, 21, and 30-32.

If the Examiner maintains the double patenting rejection, Applicant will respectfully submit a terminal disclaimer to obviate the judicially created double patenting rejection.

III) NEW CLAIMS

Applicant has added new claims 33-37.

New claim 33 is a new independent claim having somewhat similar claim elements to that of independent claim 14. New claim 33 recites an "instruction set architecture (ISA) for voice over internet protocol (VOIP)" to clarify the practical application of

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Applicant's claimed invention. New claim 33 further recites "a set of instructions for operation within a digital signal processor to convert between samples and packets for voice and data communication over a network" in the body of the claim.

Thus, Applicant respectfully submits that independent claim 33 is used to produce a "useful, concrete and tangible result" and is proper statutory subject matter.

New claims 34-37 depend directly or indirectly from independent claim 33.

Thus, Applicant respectfully submits that new claim 33-37 are also in condition for allowance.

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CONCLUSION

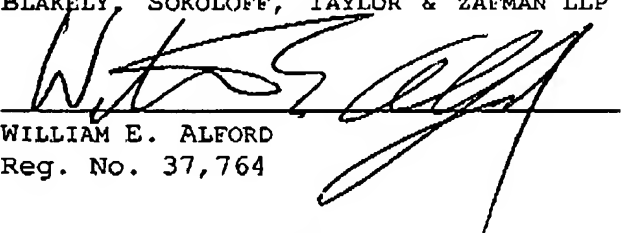
In view of the foregoing it is submitted that the claims are in condition for allowance. Reconsideration of the rejections and objections is requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant's undersigned counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such deposit account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

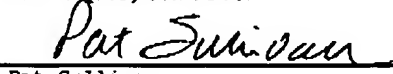
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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted via facsimile to the Patent and Trademark Office under 37 CFR §1.8 on: to Examiner Kenneth Kim at (703) 872-9306.


Pat Sullivan
April 5, 2005
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